

## **REMARKS**

This is a full and timely response to the outstanding non-final Office Action mailed January 26, 2004. Claims 1-24 remain pending in the present application. Applicants respectfully traverse all of the rejections of the Office Action. Reconsideration and allowance of the application and presently pending claims 1-24 are respectfully requested

### **I. Response to Claim Objections**

In the Office Action, claim 14 stands objected to because informalities were allegedly found in the claim. Specifically, the term "beingn" in line 2, and the term "andincluding" in line 3 are typographical error. Claim 14 has been amended to overcome this rejection and Applicants respectfully request that the objection be withdrawn.

### **II. Response to Claim Rejection Under 35 U.S.C. §112**

In the Office Action, claim 4 stands rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter. Claim 4 has been amended to overcome this rejection and Applicants respectfully request that the rejection be withdrawn.

### **III. Response to Claim Rejection Under 35 U.S.C. §102**

Claims 1-18 and 23-24 stand rejected under 35 U.S.C. §102(e) as allegedly anticipated by U.S. Patent No. 6,314,572, to *LaRocca*, et al. Claims 19-22 stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent No. 6,662,007, to *Yuen*.

A proper rejection of a claim under 35 U.S.C. §102 requires that a single prior art reference discloses each element of the claim. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983).

#### **A. Claims 1 and 5**

1. A method for providing a television menu comprising:  
receiving an input signal from a user to provide a television menu;  
responsive to the input signal, identifying a television service that  
is currently being provided to a user; and  
including a television menu option in the television menu, ***wherein  
the television menu option is selected to be included in the television  
menu based on the identified television service and the frequency that  
the television menu option is used by the user.***

(Emphasis Added)

5. A programmable television services client device that provides television control services, said client device comprising:  
memory for storing data; and  
a processor coupled to said memory that is configured to receive an input signal from a user, responsive to the input signal, identify a television service that is currently being provided to the user, provide a television menu containing at least one television menu option, ***wherein the television menu option is selected to be included in the television menu based on the identified television service and the frequency that the television menu option is used by the user.***

(Emphasis Added)

Applicants respectfully submit that *LaRocca* fails to teach or disclose the television menu option is selected to be included in the television menu based on the identified television service and the frequency that the television menu option is used by the user. In fact, *LaRocca* discloses “[w]henever a menu selection is made, the system downloads an applet corresponding to that section [402, 404, 406, or 408] and either launches a new menu that provides further options for the subscriber or displays a selected program (e.g., starts playing a movie)” (col. 9, lines 35-40). Nowhere does *LaRocca* disclose that the television menu option is selected to be included in the television menu based on the identified television service and the frequency that the television menu option is used by the user. Accordingly, a prima facie case of anticipation cannot be established. Applicants respectfully request that claims 1 and 5 be allowed for at least this reason, among others.

B. Claims 2-4 and 6-8

Because independent claims 1 and 5 are allowable over the cited art of record, dependent claims 2-4 and 6-8 are allowable as a matter of law for at least the reason that dependent claims 2-4 and 6-8 contain all steps/features/elements of their respective independent base claims. *See, e.g., In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Accordingly, Applicant respectfully requests that the rejection to dependent claims 2-4 and 6-8 be withdrawn for this reason alone, among others.

C. Claims 9, 14, and 23

9. A programmable television services client device that provides television control services, said client device comprising:  
memory for storing data; and

a processor coupled to said memory that is configured to receive an input signal from a user, responsive to the input signal identify a type of television service that is currently being provided to the user, provide a television menu containing at least one television menu option, *wherein the television menu option is selected to be included in the television menu based on the identified type of television service and the frequency that the television menu option is used by the user.*

(Emphasis Added)

14. A method for providing a television menu comprising:  
receiving an input signal from a user to provide a television menu;  
responsive to the input signal, identifying a type of television service that is currently being provided to a user; and  
including a television menu option in the television menu, *wherein the television menu option is selected to be included in the television menu based on the identified type of television service and the frequency that the television menu option is used by the user.*

(Emphasis Added)

23. A programmable television services client device that provides television control services, said client device comprising:

means for storing data;

means for receiving an input signal from a user, responsive to the input signal identify a type of television service that is currently being provided to the user, providing a television menu containing at least one television menu option, *wherein the television menu option is selected to be included in the television menu based on the identified type of television service and the frequency that the television menu option is used by the user.*

(Emphasis Added)

Applicants respectfully submit that *LaRocca* fails to teach or disclose the television menu option is selected to be included in the television menu based on the identified type of television service and the frequency that the television menu option is used by the user. In fact, *LaRocca* discloses “[w]henever a menu selection is made, the system downloads an applet corresponding to that section [402, 404, 406, or 408] and either launches a new menu that provides further options for the subscriber or displays a selected program (e.g., starts playing a movie)” (col. 9, lines 35-40). Nowhere does *LaRocca* disclose that the television menu option is selected to be included in the television menu based on the identified type of television service and the frequency that the television menu option is used by the user. Accordingly, a prima facie case of anticipation cannot be established. Applicants respectfully request that claims 9, 14, and 23 be allowed for at least this reason, among others.

D. Claims 10-13, 15-18, and 24

Because independent claims 9, 14, and 23 are allowable over the cited art of record, dependent claims 10-13, 15-18, and 24 are allowable as a matter of law for at least the reason that dependent claims 10-13, 15-18, and 24 contain all steps/features/elements of their respective independent base claims. *In re Fine, supra*. Accordingly, Applicants respectfully request that the rejection to dependent claims 10-13, 15-18, and 24 be withdrawn for this reason alone, among others.

E. Claims 19 and 21

19. A programmable television services client device that provides television control services, said client device comprising:  
memory for storing data; and  
a processor coupled to said memory that is configured to receive an input signal from a user, responsive to the input signal, identify a type of television channel that is currently being provided to the user, provide a television menu containing at least one television menu option, *wherein the television menu option is selected to be included in the television menu based on the identified type of television channel and the frequency that the television menu option is used by the user.*

(Emphasis Added)

21. A programmable television services client device that provides television control services, said client device comprising:  
means for storing data;  
means for receiving an input signal from a user, responsive to the input signal, identifying a type of television channel that is currently being provided to the user, providing a television menu containing at least one television menu option, *wherein the television menu option is selected to be included in the television menu based on the identified type of television channel and the frequency that the television menu option is used by the user.*

(Emphasis Added)

Applicants respectfully submit that *Yuen* fails to teach or disclose the television menu option is selected to be included in the television menu based on the identified type of television channel and the frequency that the television menu option is used by the user. In fact, *Yuen* discloses “the microprocessor creates a list of available service providers as they are received and assigned each service provider a provider reference number 400 which is stored in memory 208....the microprocessor displays on the television 10 a catalog display 406 which includes a list of items available from that particular service provider and the corresponding item reference number for each item, as shown in Fig. 8. The viewer selects an item by pressing a button on the Keypad 214 corresponding to the Item Reference Number 404 for that item.” (col. 13, lines 5-39). Nowhere does *Yuen* disclose that the television menu option is selected to be included in the television menu based on the identified type of television channel and the frequency that the television menu option is used by the user. Accordingly, a prima facie case of anticipation

cannot be established. Applicants respectfully request that claims 19 and 21 be allowed for at least this reason, among others.

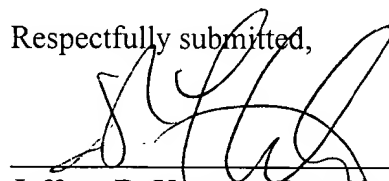
F. Claims 20 and 22

Because independent claims 19 and 21 are allowable over the cited art of record, dependent claims 20 and 22 are allowable as a matter of law for at least the reason that dependent claims 20 and 22 contain all steps/features/elements of their respective independent base claims. *In re Fine, supra*. Accordingly, Applicant respectfully requests that the rejection to dependent claims 20 and 22 be withdrawn for this reason alone.

**CONCLUSION**

In light of the foregoing amendments and for at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1-24 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,



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